

S.N. 10/654,550
Howard Hooper
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REMARKS

Claims 2, 5-7, 9, 12 and 23-38 were pending in the application prior to this response. Claims 2, 5-7, 9, 12 and 23-38 remain in the application unchanged.

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I. Rejection of Claims 2, 5-7, 9 and 12 over Okamoto

Claims 2, 5-7, 9 and 12 stand rejected under 35 U.S.C. §102(b) as being anticipated by Okamoto (JP 09-179468). Reexamination and reconsideration of the Examiner's rejection are requested.

Claims 2 and 5-7

Independent claim 2 recites the following:

A converter for converting a non waste-residue collecting toner cartridge to a waste-residue collecting toner cartridge, the converter comprising:

a) a waste-residue collection site with an opening wherein the opening is positionable proximate a photo conductor drum disposed within the cartridge;

b) a waste-residue remover operably associateable with the photo conductor drum;

wherein the waste-residue remover is a scraper;

wherein the waste-residue collection site is a waste-residue hopper; and

wherein said waste-residue hopper and said scraper are selectively removable as a unit from said waste-residue collecting toner cartridge.

In the preamble of claim 2, a "converter for converting a non waste-residue collecting toner cartridge to a waste-residue collecting toner cartridge" is recited. Okamoto clearly does not disclose such a converter.

On pages 2-3 of the final Office action, the Examiner indicates that the

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limitation discussed above will not be given patentable weight because it appears in the preamble of the claim. For the reasons set forth below, applicant respectfully requests that the Examiner reconsider this position.

The MPEP discusses the weight to be given preamble limitations, for example, as follows:

Any terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation.

(MPEP 2111.02, citations omitted)

The claim 2 preamble terminology a "converter for converting a non waste-residue collecting toner cartridge to a waste-residue collecting toner cartridge" clearly limits the structure of claim 2 since this terminology establishes that a "converter" is being claimed.

MPEP 2111.02 also states the following:

"[A] claim preamble has the import that the claim as a whole suggests for it." *Bell Communications Research, Inc. v. Vitalink Communications Corp.*, 55 F.3d 615,620, 34 USPQ2d 1816, 1820 (Fed. Cir. 1995). "If the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is 'necessary to give life, meaning, and vitality' to the claim, then the claim preamble should be construed as if in the balance of the claim." *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999). See also *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951) (a preamble reciting "An abrasive article" was deemed essential to point out the invention defined by claims to an article comprising abrasive grains and a hardened binder and the process of making it. The court stated "it is only by that phrase that it can be known that the subject matter defined by the claims is comprised as an abrasive article. Every union of substances capable *inter alia* of use as abrasive grains and a binder is not an 'abrasive article.'" Therefore, the preamble served to further define the structure of the article produced.).

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The present situation is particularly analogous to that of *Kropa v. Robie* in that it is only by applicant's preamble that the subject matter defined by claim 2 is known to be comprised as a converter. Accordingly, it is improper for the Examiner to completely ignore this limitation.

Claims 5-7 are allowable at least as depending from allowable base claim 2.

Claims 9 and 12

Applicant's independent claim 9 recites the following:

A converter for converting a non waste-residue collecting toner cartridge to a waste-residue collecting toner cartridge, the converter comprising:

a) means, comprising a waste-residue hopper, for collecting waste-residue from the photo conductor drum;

b) means, comprising a scraper, for removing waste-residue from the photo conductor drum and directing the waste-residue into the means for collecting waste-residue;

wherein said waste-residue hopper and said scraper are selectively removable as a unit from said waste-residue collecting toner cartridge.

In a manner similar to claim 2, claim 9 recites, in the preamble, a "converter for converting a non waste-residue collecting toner cartridge to a waste-residue collecting toner cartridge". Accordingly, claim 9 is allowable for at least the reasons advanced above with respect to claim 2.

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Claim 12 is allowable at least as depending from allowable base claim

9.

II. Rejection of Claims 2, 5-7, 9 and 12 over Honda

Claims 2, 5-7, 9 and 12 stand rejected under 35 U.S.C. §102(b) as being anticipated by Honda (US 4,985,734). Reexamination and reconsideration of the Examiner's rejection are requested.

Claims 2 and 5-7

Independent claim 2 recites the following:

A converter for converting a non waste-residue collecting toner cartridge to a waste-residue collecting toner cartridge, the converter comprising:

a) a waste-residue collection site with an opening wherein the opening is positionable proximate a photo conductor drum disposed within the cartridge;

b) a waste-residue remover operably associateable with the photo conductor drum;

wherein the waste-residue remover is a scraper;

wherein the waste-residue collection site is a waste-residue hopper; and

wherein said waste-residue hopper and said scraper are selectively removable as a unit from said waste-residue collecting toner cartridge.

In the preamble of claim 2, a "converter for converting a non waste-

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residue collecting toner cartridge to a waste-residue collecting toner cartridge" is recited. Honda clearly does not disclose such a converter.

On pages 3-4 of the final Office action, the Examiner indicates that the limitation discussed above will not be given patentable weight because it appears in the preamble of the claim. Accordingly, applicant's arguments set forth above with respect to the rejection of claim 2 over Okamoto are applicable to the rejection over Honda as well and applicant hereby reasserts these arguments. Again, applicant respectfully requests that the Examiner reconsider this position.

Claims 9 and 12

Applicant's independent claim 9 recites the following:

A converter for converting a non waste-residue collecting toner cartridge to a waste-residue collecting toner cartridge, the converter comprising:

a) means, comprising a waste-residue hopper, for collecting waste-residue from the photo conductor drum;

b) means, comprising a scraper, for removing waste-residue from the photo conductor drum and directing the waste-residue into the means for collecting waste-residue;

wherein said waste-residue hopper and said scraper are selectively removable as a unit from said waste-residue collecting toner cartridge.

In a manner similar to claim 2, claim 9 recites, in the preamble, a "converter for converting a non waste-residue collecting toner cartridge to a waste-residue collecting toner cartridge". Accordingly, claim 9 is allowable for

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at least the reasons advanced above with respect to claim 2.

Claim 12 is allowable at least as depending from allowable base claim 9.

III. Allowable Subject Matter

The Examiner indicates, on page 4 of the Office action, that claims 23-38 are allowed.

For at least the reasons advanced above, it is believed that all of the claims are in condition for allowance.

Respectfully submitted,
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